

EDWARD P. WALKER (*Pro Hac Vice*)
 JOHN W. O'MEARA (*Pro Hac Vice*)
 VU Q. BUI (*Pro Hac Vice*)
 OLIFF & BERRIDGE, PLC
 277 South Washington Street, Suite 500
 Alexandria, VA 22314
 Telephone: (703) 836-6400
 Facsimile: (703) 836-2787
ewalker@oliff.com; jomeara@oliff.com; vbui@oliff.com

KENNETH L. NISSLY (CA Bar No. 77589)
 SUSAN van KEULEN (CA Bar No. 136060)
 THELEN REID & PRIEST LLP
 225 West Santa Clara Street, Suite 1200
 San Jose, CA 95113-1723
 Telephone: (408) 292-5800
 Facsimile: (408) 287-8040
kennissly@thelenreid.com; svankeulen@thelenreid.com

Attorneys for Defendant/Counterclaim Plaintiff
 Rossignol Ski Company, Inc.

**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 (SAN FRANCISCO DIVISION)**

RICHARD W. BERGER and
 BRANT W. BERGER,

 Plaintiffs,

 v.

 ROSSIGNOL SKI COMPANY, INC.,

 Defendant.

Case No. 3:05-CV-02523-CRB

**ROSSIGNOL'S MOTION FOR
 SUMMARY JUDGMENT OF
 UNENFORCEABILITY (DUE TO
 EQUITABLE ESTOPPEL),
 NONINFRINGEMENT AND/OR
 INVALIDITY**

ROSSIGNOL SKI COMPANY, INC.,

 Counterclaim Plaintiff,

 v.

 RICHARD W. BERGER and
 BRANT W. BERGER,

 Counterclaim Defendants.

Date: March 31, 2006
 Time: 10:00 a.m.
 Place: San Francisco
 Courtroom 8, 19th Floor
 Before: District Judge Charles R. Breyer

TABLE OF CONTENTS

I.	STATEMENT OF THE ISSUES AND SUMMARY OF ARGUMENT	2
II.	BACKGROUND AND UNDISPUTED MATERIAL FACTS	3
A.	The 530 Patent.....	3
B.	The Accused Rossignol Snowboard Binding	4
C.	Plaintiffs' Delay In Bringing This Action	5
D.	Plaintiffs' Belated Infringement Contentions	7
III.	LAW AND ARGUMENT.....	7
A.	Summary Judgment Standard.....	7
B.	In View of Plaintiffs' Long Delay Of More Than Six Years In Asserting Their Patent Rights Against Rossignol, And The Resultant Material Prejudice To Rossignol, Plaintiffs Should Be Estopped From Maintaining This Action Against Rossignol	8
1.	Law Relating To Equitable Estoppel	8
2.	Plaintiffs Should Be Equitably Estopped From Maintaining This Action Against Rossignol	9
C.	Even If Enforceable, Plaintiffs' Asserted Patent Claims Are Not Infringed By Rossignol's Accused Binding, As Admitted By Plaintiffs	11
1.	Law Relating To Noninfringement.....	12
2.	Plaintiffs Have Admitted That Rossignol's Accused Binding Is Missing The "Rotation Of The Upper Attachment Relative To The Lower Attachment" Element Of The Asserted Claims, And Therefore Does Not Infringe.....	13
3.	Plaintiffs Have Admitted That Rossignol's Accused Binding Is Missing The "Automatically Engage With Each Other To Lock ... And To Permit Rotation" Element of the Asserted Claims, And Therefore Does Not Infringe	14
4.	Plaintiffs Have Admitted That Rossignol's Accused Binding Is Missing The "Without Release" Element Of The Asserted Claims, And Therefore Does Not Infringe.....	15

1	5. Plaintiffs Have Admitted That Rossignol's Accused Binding Is	
2	Missing The "Coupling Mount Attached ..." Element Of The	
3	Asserted Claims, And Therefore Does Not Infringe.....	16
4	D. The Asserted Claims Of The 530 Patent Are Invalid, Particularly If	
5	Applied So As To Cover Rossignol's Accused Binding	17
6	1. Law Relating to Invalidity	18
7	2. Plaintiffs' Asserted Claims Are Invalid Under 35 U.S.C. §102(b)	
8	As Anticipated By PCT Publication WO 89/08480 (AITEC)	20
9	3. Plaintiffs' Asserted Claims Are Invalid Under 35 U.S.C. §102(b)	
10	As Anticipated By French Patent Publication 2,618,688 (Scott).....	20
11	4. Plaintiffs' Asserted Claims Are Alternatively Invalid Under	
12	35 U.S.C. §103(a) For Obviousness From AITEC Or Scott	
13	InView Of One Another And/Or Additional Prior Art.....	21
14	IV. CONCLUSION	25

TABLE OF AUTHORITIES

Cases

<i>A.C. Aukerman Co. v. R.L. Chaides Constr. Co.</i> , 960 F.2d 1020 (Fed. Cir. 1992).....	8, 11
<i>ABB Robotics Inc. v. GMFanuc Robotics Corp.</i> , 52 F.3d 1062 (Fed. Cir. 1995).....	9, 11
<i>Amazon.com, Inc. v. Barnesandnoble.com, Inc.</i> , 239 F.3d 1343 (Fed. Cir. 2001).....	12
<i>Bayer AG v. Elan Pharm. Research Corp.</i> , 212 F.3d 1241 (Fed. Cir. 2000).....	13
<i>Brown v. 3M</i> , 265 F.3d 1349 (Fed. Cir. 2001).....	18
<i>Celeritas Techs. Ltd. v. Rockwell Int'l Corp.</i> , 150 F.3d 1354 (Fed. Cir. 1998).....	18
<i>Cole v. Kimberly-Clark Corp.</i> , 102 F.3d 524 (Fed. Cir. 1996).....	13
<i>Desper Prods., Inc. v. QSound Labs, Inc.</i> , 157 F.3d 1325 (Fed. Cir. 1998).....	8
<i>Faroudja Labs., Inc. v. Dwin Elecs., Inc.</i> , 1999 WL 111788 (N.D. Cal. 1999).....	12
<i>Freedman Seating Co. v. American Seating Co.</i> , 420 F.3d 1350 (Fed. Cir. 2005).....	13
<i>Globetrotter Software, Inc. v. Elan Computer Group, Inc.</i> , 1999 WL 33490210 (N.D. Cal. 1999).....	12
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	19
<i>In re Gorman</i> , 933 F.2d 982 (Fed. Cir. 1991).....	24
<i>In re GPAC, Inc.</i> , 57 F.3d 1573 (Fed. Cir. 1995).....	19
<i>Iron Grip Barbell Co. v. USA Sports, Inc.</i> , 392 F.3d 1317 (Fed. Cir. 2004).....	18

1	<i>Kansas Jack, Inc. v. Kuhn,</i>	
2	719 F.2d 1144 (Fed. Cir. 1983).....	24
3	<i>Markman v. Westview Instruments, Inc.,</i>	
4	52 F.3d 967 (Fed. Cir. 1995).....	12
5	<i>Medical Instrumentation and Diagnostics Corp. v. Elekta AB,</i>	
6	344 F.3d 1205 (Fed. Cir. 2003).....	19
7	<i>Pfaff v. Wells Elecs., Inc.,</i>	
8	124 F.3d 1429 (Fed. Cir. 1997).....	19
9	<i>Phillips v. AWH Corp.,</i>	
10	415 F.3d 1303 (Fed. Cir. 2005).....	12
11	<i>Rogers v. Desa Int'l, Inc.,</i>	
12	166 F.Supp.2d 1202 (E.D. Mich. 2001).....	12
13	<i>Sandt Tech., Ltd. v. Resco Metal and Plastics Corp.,</i>	
14	264 F.3d 1344 (Fed. Cir. 2001).....	8
15	<i>Scholle Corp. v. Blackhawk Molding Co.,</i>	
16	133 F.3d 1469 (Fed. Cir. 1998).....	8, 9, 10, 11
17	<i>Searfoss v. Pioneer Consolidated Corp.,</i>	
18	374 F.3d 1142 (Fed. Cir. 2004).....	17
19	<i>SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.,</i>	
20	225 F.3d 1349 (Fed. Cir. 2000).....	18, 19
21	<i>Southwall Techs., Inc. v. Cardinal IG Co.,</i>	
22	54 F.3d 1570 (Fed. Cir. 1995).....	8, 11
23	<i>Telemac Cellular Corp. v. Topp Telecom, Inc.,</i>	
24	247 F.3d 1316 (Fed. Cir. 2001).....	7, 8
25	<i>Transclean Corp. v. Bridgewood Servs., Inc.,</i>	
26	290 F.3d 1364 (Fed. Cir. 2002).....	19
27	<i>Vivid Techs., Inc. v. American Science & Eng'r., Inc.,</i>	
28	200 F.3d 795 (Fed. Cir. 1999).....	12
	<i>Warner-Jenkinson Co. v. Hilton Davis Chemical Co.,</i>	
	520 U.S. 17 (1997).....	13
	<i>Wilson Sporting Goods Co. v. David Geoffrey & Assocs.,</i>	
	904 F.2d 677 (Fed. Cir. 1990).....	14
	<i>Zodiac Pool Care Inc. v. Hoffinger Indus. Inc.</i>	
	206 F.3d 1408 (Fed. Cir. 2000).....	13

Statutes

35 U.S.C. §102	19
35 U.S.C. §102(b)	21, 22, 23
35 U.S.C. §102(e).....	22
35 U.S.C. §103(a).....	19

TABLE OF EXHIBITS

The following is a table of the exhibits to this motion, authenticated by the accompanying Declaration of John W. O'Meara:

<u>Exhibit No.</u>	<u>Description</u>
1.	U.S. Patent No. 5,913,530 to Berger et al.
2.	Photographs of Rossignol's Accused Snowboard Binding
3.	Declaration of Gilles Marmonier and attached Exhibits A through K
4.	Plaintiffs' Preliminary Infringement Contentions
5.	International PCT Publication No. WO 89/08480 ("AITEC") and Certified English Translation
6.	French Patent Publication No. 2,618,688 to Scott de Martinville ("Scott") and Certified English Translation
7.	U.S. Patent No. 5,660,410 to Alden ("Alden")
8.	U.S. Patent No. 5,520,406 to Anderson et al. ("Anderson")
9.	U.S. Patent No. 5,577,755 to Metzger et al. ("Metzger")
10.	Rossignol's Chart Applying the Asserted Claims of U.S. Patent No. 5,913,530 to the Prior Art AITEC Publication
11.	Rossignol's Chart Applying the Asserted Claims of U.S. Patent No. 5,913,530 to the Prior Art Scott Publication
12.	Rossignol's Chart Applying the Asserted Claims of U.S. Patent No. 5,913,530 to the Prior Art Alden Patent
13.	Rossignol's Chart Applying the Asserted Claims of U.S. Patent No. 5,913,530 to the Prior Art Anderson Patent
14.	Rossignol's Chart Applying the Asserted Claims of U.S. Patent No. 5,913,530 to the Prior Art Metzger Patent
15.	1990/1991 Look Snowboards Brochure and Certified English Translation
16.	<i>Faroudja Labs., Inc. v. Dwin Elecs., Inc.</i> , 1999 WL 111788 (N.D. Cal. 1999)
17.	<i>Globetrotter Software, Inc. v. Elan Computer Group, Inc.</i> , 1999 WL 33490210 (N.D. Cal. 1999)

PLEASE TAKE NOTICE that Defendant/Counterclaim Plaintiff Rossignol Ski Company, Inc. ("Defendant" or "Rossignol"), by and through its attorneys, will respectfully move this Court before the Honorable Charles R. Breyer, on March 31, 2006 at 10:00 a.m. at the United States Courthouse, 450 Golden Gate Avenue, Courtroom 8, 19th Floor, San Francisco, California, for summary judgment declaring the patents asserted by Plaintiffs in this action¹ to be unenforceable, not infringed and/or invalid, and for dismissal of this action with prejudice.

More particularly, Rossignol will respectfully move this Court, pursuant to Fed. R. Civ. P. 56 and Civil L.R. 56, for the entry of summary judgment on three grounds. First, Plaintiffs' asserted patents are unenforceable against Rossignol (and this action should be barred) based on equitable estoppel due to the lengthy and unjustified delay by Plaintiffs -- spanning a period of more than six years -- in asserting their patents against Rossignol. Second, Plaintiffs' asserted patent claims are not infringed by the Rossignol snowboard binding accused of infringement by Plaintiffs, at least because, by Plaintiffs' own admissions, a number of claim elements are missing from Rossignol's accused binding. Third, the asserted claims are invalid in view of the prior art, particularly if applied so as to cover Rossignol's accused binding.

The detailed reasons supporting Rossignol's motion are explained in the following Memorandum of Points and Authorities, and in the Declarations of John W. O'Meara ("O'Meara Decl.") and Gilles Marmonier ("Marmonier Decl.") with attached exhibits filed concurrently herewith. In accordance with Civil L.R. 7-2, a proposed Order is also filed herewith.

MEMORANDUM OF POINTS AND AUTHORITIES

I. STATEMENT OF THE ISSUES AND SUMMARY OF ARGUMENT

The issues presented by this motion are whether: (1) Plaintiffs' action is barred by equitable estoppel, (2) Plaintiffs' asserted patent claims are not infringed, and (3) Plaintiffs'

¹ Plaintiffs' Second Amended Complaint references both U.S. Patent No. 5,913,530 ("530 Patent") and U.S. Patent No. 5,196,569 ("569 Patent"). However, in Plaintiffs' Infringement Contentions served on January 4, 2006, Plaintiffs indicated that they are asserting only claims 1, 2, 4-6, 8, 19, 21-23, 26-28 and 30 of the 530 Patent and no claims of the 569 Patent.

1 asserted patent claims are invalid in view of the prior art. Rossignol respectfully submits that
 2 these issues should be decided, and summary judgment should be entered, in Rossignol's favor.

3 Plaintiffs contacted Rossignol in 1998 regarding the possible applicability of Plaintiffs'
 4 prospective patents to a snowboard binding that had been recently introduced by Rossignol. After
 5 Rossignol explained that its binding would not infringe Plaintiffs' patents, Rossignol did not hear
 6 further from Plaintiffs after May 1999 until served with Plaintiffs' First Amended Complaint on
 7 October 4, 2005. Meanwhile, in reliance on Plaintiffs' silence and inaction, Rossignol proceeded
 8 to manufacture, market and sell products containing the previously discussed binding that is now
 9 the subject of this lawsuit. Thus, Plaintiffs should be equitably estopped as a matter of law from
 10 maintaining this action in order to avoid material prejudice to Rossignol.

11 Even if this action could be continued by Plaintiffs, the asserted claims of the 530 Patent
 12 are not infringed by the accused Rossignol binding. Indeed, Plaintiffs, in vainly trying to read the
 13 asserted 530 Patent claims on Rossignol's binding, have been forced to tacitly admit that a number
 14 of claim elements are missing from the binding. Moreover, if Plaintiffs' asserted claims are
 15 applied so as to cover Rossignol's binding, the claims are clearly invalid in view of the prior art.

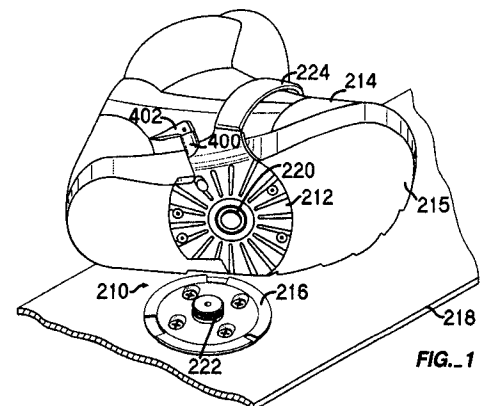
16 **II. BACKGROUND AND UNDISPUTED MATERIAL FACTS**

17 **A. The 530 Patent**

18 The 530 Patent (Ex. 1) discloses a rotatable,
 19 automatic engagement snowboard binding in which
 20 a single coupling mechanism is used both to lock
 21 the boot to the board and to permit rotation of the
 22 boot with respect to the board, such that a
 23 snowboarder can step onto the board and then rotate

24 the boot to a selected rotary position without having

25 to first actuate a rotation release mechanism. The 530 Patent (Fig. 1 shown here with enlarged ref.
 26 nos.) describes such a binding 210, with an upper attachment plate 212 and a coupler 220 fixed to
 27 a boot 214, and a lower attachment plate 216 and a coupling mount 222 fixed to a snowboard 218.



Figs. 2 through 4 and the corresponding written description provide details of the upper and lower attachment plates, coupler and coupling mount. Figs. 5-27 and the corresponding written description provide details of an alternative, similar embodiment of a binding.

Claim 1 of the 530 Patent, the only independent claim asserted by Plaintiffs, recites: "A binding, comprising: a boot comprising an upper attachment, a lower attachment connectable to a board, a coupler attached to one of said upper and lower attachments, and a coupling mount attached to the other of said upper and lower attachments," and further recites:

the coupling mount and the coupler being configured to automatically engage with each other to lock the upper attachment to the lower attachment when a user wearing the boot steps onto the lower attachment and to permit rotation of the upper attachment relative to the lower attachment when the upper attachment is locked to the lower attachment without release of said upper attachment from said lower attachment.

The dependent claims of the 530 Patent asserted by Plaintiffs, i.e., claims 2, 4-6, 8, 19, 21-23, 26-28 and 30, recite additional details of the binding of claim 1.

B. The Accused Rossignol Snowboard Binding

Rossignol's accused snowboard binding (see Ex. 2 photographs, one set forth here) includes a base 1 rotatably mounted to a snowboard atop a disc 2 (by means of a central hold-down disc, not shown), and a pair of lateral jaws 3 on base 1 that interact with pins 4 laterally extending from the bottom of a snowboard boot. Pins 4 engage with jaws 3 to lock the boot to the



binding and snowboard when a snowboarder steps onto the snowboard, whereas rotation of the boot relative to the snowboard is permitted by the rotatability of base 1 upon actuation of a release mechanism 5 that releases gear 6 from engagement with teeth on the periphery of disc 2 (beneath base 1).

1 **C. Plaintiffs' Delay In Bringing This Action**

2 As far back as April 1998, more than seven years before the filing of the original
3 Complaint in this case, Plaintiffs' attorney first contacted Rossignol, through Rossignol's then
4 President (Mr. Rodet), its then CEO (Mr. Vives), and its parent company, regarding Plaintiffs'
5 alleged invention. At that time, Plaintiffs' attorney advised Rossignol of Plaintiffs' International
6 PCT Publication No. WO 97/49464, stated that "the claimed subject matter in the PCT application
7 presents an issue of potential infringement" with respect to a rotatable step-in binding that had
8 been recently introduced by the Rossignol Group of companies, and further indicated that
9 Plaintiffs were interested in meeting with Rossignol to discuss a possible collaboration with
10 respect to Plaintiffs' rotatable step-in binding. In May 1998, Rossignol wrote to Plaintiffs' attorney
11 that "we consider that our products don't infringe your clients' patent right" and that "in our
12 opinion the claims which could concern our rotating step-in snowboard bindings cannot be
13 accepted by the Patent Office due to a lot of prior arts," but that Rossignol was willing to meet
14 with Plaintiffs as Plaintiffs requested. (Ex. 3, Marmonier Decl., ¶¶ 2-4 and Exs. A and B).

15 In May 1998, Plaintiff Richard Berger wrote to Rossignol (1) acknowledging Rossignol's
16 "view of infringement," (2) conclusorily stating the Bergers' positions of infringement and validity,
17 and (3) expressing an interest in a business relationship with the "Rossignol Group," which
18 included Rossignol Ski Company, Inc. In June 1998, Rossignol wrote Mr. Berger, indicating
19 Rossignol's availability for a meeting but reiterating that "we do confirm that in our opinion we
20 don't infringe valid claims of your patent." (Ex. 3, Marmonier Decl., ¶ 4 and Exs. C and D).

21 Plaintiffs Richard Berger and Brant Berger then met with representatives of Rossignol in
22 July 1998, and provided Rossignol at that time with some binding samples for Rossignol's
23 consideration. However, in October 1998, Rossignol wrote to Richard Berger indicating that, due
24 to problems with the Berger binding, Rossignol had decided not to use it. In March 1999, the
25 Bergers' attorney advised Rossignol that the Bergers' corresponding U.S. patent application (i.e.,
26 the application that issued as the 530 Patent) had been allowed, and that the Bergers would again
27 like to meet with Rossignol representatives to discuss the situation. On March 11, 1999,

1 Rossignol's Mr. Rodet met with the Bergers, as requested. On March 30, 1999, after reviewing the
2 Bergers' allowed U.S. claims, Rossignol advised the Bergers' attorney that Rossignol intended to
3 continue with its own rotatable step-in snowboard binding. (Ex. 3, Marmonier Decl., ¶ 4 and Exs.
4 E through I).

5 On April 28, 1999, the Bergers' attorney again wrote to Rossignol stating that the U.S.
6 patent claims would cover many configurations of the Bergers' binding, "*possibly* also including
7 Rossignol's Tool less SIS Step-In snowboard binding" (emphasis added), and further stating that
8 Rossignol should determine whether it needed a license from the Bergers. On May 6, 1999,
9 Rossignol wrote to the Bergers' attorney stating that "[f]rom our point of view the question of
10 potential infringement of the patent of Mr. BERGER by ROSSIGNOL's TOOL LESS Step-in
11 binding was already solved." The letter further (1) summarized the contacts between the parties
12 from April 1998 to March 1999, (2) expressed Rossignol's belief, after reviewing the U.S. granted
13 claims, that Rossignol did not need a license because its products would not infringe the Bergers'
14 prospective U.S. patent, and (3) forwarded a sample of Rossignol's products "to make sure that you
15 have a good understanding of our product." Rossignol further stated in its May 6, 1999 letter that:

16 As you can see it, the Step-in system and the angle adjustement [sic] are two
17 different fonctions [sic] as you can find this device on a lot of products of prior art.

18 On BERGER's products and in BERGER's patent, we can read that:

19 "The coupling mount and the coupler being configured to automatically engage
20 with each other to lock the upper attachment to the lower attachment...and to
21 permit rotation of the upper attachment relative to the lower attachment when the
22 upper attachment is locked to the lower attachment"...

23 It is clear that on the products sold by the ROSSIGNOL Group, the horizontal axis
24 does not allow the boot to rotate and it is the reason why we located this fonction
25 [sic] in an other place of the binding.

26 We are sure that this short explanation will convince you that our products don't
27 infringe BERGER's patent.

28 (Ex. 3, Marmonier Decl., ¶ 5 and Exs. J and K).

Thus, Rossignol's May 6, 1999 letter made clear that products sold by the Rossignol Group,
which included Rossignol Ski Company, Inc., would not infringe the Bergers' U.S. patent. Neither
the Bergers nor their attorney ever responded to Rossignol's May 6, 1999 letter, i.e., they never

1 indicated their disagreement with Rossignol's assessment that it would not infringe the Bergers'
2 U.S. patent and therefore did not need a license. Rather, on June 21, 2005, after over six years of
3 silence and inaction by the Bergers, the Bergers filed this case, and even then did not serve
4 Rossignol until October 4, 2005. (Ex. 3, Marmonier Decl., ¶ 6).

5 **D. Plaintiffs' Belated Infringement Contentions**

6 According to Patent L.R. 3-1 and 3-2, Plaintiffs' Infringement Contentions were to be
7 served within 10 days of the November 18, 2005 Initial Case Management Conference. However,
8 despite repeated requests from Rossignol following the Initial Case Management Conference,
9 Plaintiffs further delayed their action against Rossignol by not serving their Infringement
10 Contentions until January 4, 2006.

11 In their Infringement Contentions (Ex. 4), Plaintiffs assert independent claim 1 and
12 dependent claims 2, 4-6, 8, 19, 21-23, 26-28 and 30 of the 530 Patent against one illustrated
13 Rossignol snowboard binding (hereinafter "accused binding"). Plaintiffs' Infringement
14 Contentions include various photographs of Rossignol's accused binding, with various parts of
15 those products numbered as allegedly corresponding to elements of Plaintiffs' asserted claims.
16 However, Plaintiffs' Infringement Contentions refer to numbered parts that are not identified in the
17 photographs. This includes alleged numbered parts 17, 19, 21, 24 and 25.

18 Thus, Plaintiffs' Infringement Contentions fail to meet Plaintiffs' burden of demonstrating
19 infringement by Rossignol's accused binding. Indeed, as demonstrated below, Plaintiffs'
20 Infringement Contentions concede that Rossignol's accused binding is missing several elements of
21 Plaintiffs' asserted patent claims.

22 **III. LAW AND ARGUMENT**

23 **A. Summary Judgment Standard**

24 Summary judgment should be granted where, as here, there is no genuine issue as to any
25 material fact and Rossignol is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *see*
26 *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001). "Summary
27
28

judgment is as appropriate in a patent case as it is in any other case." *Desper Prods., Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998). In particular, the defenses of equitable estoppel, noninfringement and invalidity are all appropriately decided on summary judgment where the undisputed material facts mandate the entry of judgment as a matter of law. *Telemac*, 247 F.3d at 1327 (summary judgment of anticipation); *Sandt Tech., Ltd. v. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1347-48, 1354 (Fed. Cir. 2001) (summary judgment of obviousness); *Scholle Corp. v. Blackhawk Molding Co.*, 133 F.3d 1469, 1471 (Fed. Cir. 1998) (summary judgment of equitable estoppel); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995) (summary judgment of noninfringement).

B. In View of Plaintiffs' Long Delay Of More Than Six Years In Asserting Their Patent Rights Against Rossignol, And The Resultant Material Prejudice To Rossignol, Plaintiffs Should Be Estopped From Maintaining This Action Against Rossignol

1. Law Relating To Equitable Estoppel

Equitable estoppel is a defense to infringement that may serve as an absolute bar to a patentee's claim of infringement. *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1041 (Fed. Cir. 1992) (*en banc*). Three elements must be established to bar a patentee's suit on the basis of equitable estoppel: (1) misleading conduct by the patentee that leads the alleged infringer to reasonably infer that the patentee does not intend to enforce its patent against the alleged infringer, (2) reliance on that conduct by the alleged infringer, and (3) material prejudice to the alleged infringer if the patentee is allowed to proceed with its claim. *Id.* at 1028. The first "conduct" element may include specific statements, action, inaction, or silence where there was an obligation to speak. *Id.*

Equitable estoppel has been held to apply based upon a course of dealings between a patentee and an alleged infringer followed by inaction on the part of the patentee. In *Scholle Corp.*, Scholle had accused Blackhawk's WATERSAFE valved bottle cap of infringing Scholle's patent. During a subsequent meeting in April 1993, Blackhawk informed Scholle of Blackhawk's redesigned SAFEGARD cap, gave Scholle samples of the SAFEGARD cap, and stated that Blackhawk would consider the SAFEGARD cap to be non-infringing unless Scholle advised

1 Blackhawk otherwise. Despite subsequent contacts between the parties, Scholle never responded
 2 to Blackhawk with respect to the SAFEGARD cap. Rather, almost three years after the above-
 3 referenced meeting, Scholle filed suit against Blackhawk for patent infringement by the
 4 SAFEGARD cap. In affirming a summary judgment determination that Scholle's suit was barred
 5 by equitable estoppel, the Court stated:

6 [W]hen the course of dealings between a patentee and an alleged infringer is such
 7 that the alleged infringer reasonably infers from the patentee's misleading conduct
 8 or inaction that the patentee has waived its patent rights, then the first element of
 equitable estoppel has been established absent a statement to the contrary by the
 patentee.

9 133 F.3d at 1472.² See also *ABB Robotics Inc. v. GMFanuc Robotics Corp.*, 52 F.3d 1062, 1063-
 10 65 (Fed. Cir. 1995) (summary judgment of equitable estoppel affirmed based upon GMF's 1986
 11 denial of infringement coupled with the patentee's inaction for almost five years before charging
 12 GMF with infringement and for almost six years before filing suit).

13 **2. Plaintiffs Should Be Equitably Estopped From**
 14 **Maintaining This Action Against Rossignol**

15 In view of the above-discussed circumstances of (1) the interactions between Rossignol
 16 and Plaintiffs in 1998 and 1999, coupled with (2) the Plaintiffs' silence and inaction for over six
 17 years before filing suit against Rossignol, (3) Rossignol's reliance upon Plaintiffs' conduct, and
 18 (4) the material prejudice that Rossignol would experience if Plaintiffs were now allowed to
 19 proceed with this action, Plaintiffs should be estopped from maintaining this action against
 20 Rossignol.

21 Like the patent owner in the *Scholle* case discussed above, Plaintiffs sent a letter regarding
 22 their alleged patent rights to Rossignol (in April 1998), and, also like *Scholle*, a course of
 23 discussions and contacts between the parties followed. Also as in *Scholle*, Rossignol informed
 24 Plaintiffs on various occasions over the next year that Rossignol's products did not infringe
 25 Plaintiffs' alleged patent rights. Rossignol even provided Plaintiffs with a sample Rossignol

26 ² The Court also found the other two elements for equitable estoppel, i.e., Blackhawk relied upon
 27 Scholle's conduct and would have been materially prejudiced if Scholle was allowed to proceed
 28 with its claim.

1 product, as did the accused infringer in *Scholle*, "to make sure [Plaintiffs had] a good
2 understanding of [Rossignol's] product." (Ex. 3, Marmonier Decl., ¶ 5 and Ex. K). Finally, in its
3 May 6, 1999 letter, Rossignol specifically explained that its products did not infringe Plaintiffs'
4 then-pending allowed U.S. patent application claims (which issued as the 530 Patent claims).

5 With full awareness of both the products being marketed and sold by Rossignol and
6 Rossignol's belief that it was free to continue marketing and selling such products without
7 infringing Plaintiffs' U.S. patent, Plaintiffs, like the patent owner in *Scholle*, never responded to
8 Rossignol's May 6, 1999 assertion of noninfringement of Plaintiffs' U.S. patent. Indeed, Plaintiffs
9 remained silent and inactive with respect to Rossignol until the First Amended Complaint in this
10 action was served on Rossignol on October 4, 2005. Accordingly, after May 1999, Rossignol
11 relied upon the aforementioned conduct, silence and inaction of Plaintiffs by proceeding over the
12 next six years to manufacture, market and sell various products containing the rotatable step-in
13 binding that is now accused of infringement in this action, under the reasonable assumption that
14 Plaintiffs did not intend to pursue Rossignol for alleged infringement. (Ex. 3, Marmonier
15 Decl., ¶ 7).

16 Rossignol's reliance on Plaintiffs' conduct, silence and inaction is apparent from the record.
17 After Plaintiffs' attorney first contacted Rossignol in April 1998, there was, as discussed above, a
18 series of contacts between the parties culminating in Rossignol's determination that its products
19 did not infringe Plaintiffs' pending U.S. patent claims. Thus, in Rossignol's May 6, 1999 letter,
20 responding to the April 28, 1999 letter from Plaintiffs' attorney, Rossignol expressed its
21 understanding that the matter of alleged infringement "was already solved" based on prior
22 discussions and correspondence between the parties. (Ex. 3, Marmonier Decl., ¶ 5 and Ex. K).
23 Having then recounted in detail in its May 6, 1999 letter why it believed the matter "was already
24 solved," and then not hearing from Plaintiffs, Rossignol reasonably believed all the more strongly
25 that it had solved the matter by convincing Plaintiffs that Rossignol did not infringe. (Ex. 3,
26 Marmonier Decl., ¶ 6). Accordingly, the record fully supports the conclusion that Rossignol relied
27 on the course of conduct between the parties, followed by Plaintiffs' silence and inaction, to
28

1 conclude that it would not be sued by Plaintiffs for alleged infringement. *See ABB Robotics, Inc.*,
 2 52 F.3d at 1064 (reliance element satisfied on summary judgment record where course of conduct
 3 between the parties "lulled GMF into a sense of security that it would not be sued").

4 It is further apparent that Rossignol would be materially prejudiced if Plaintiffs are allowed
 5 to proceed with this action. Prejudice may be established by showing that the maintenance of a
 6 lawsuit could result in "damages which likely would have been prevented by an earlier suit."
 7 *Aukerman*, 960 F.2d at 1033. Increased sales and associated expenditures made during the period
 8 of Plaintiffs' delay constitute economic prejudice supporting a finding of equitable estoppel. *See*,
 9 *e.g.*, *ABB Robotics, Inc.*, 52 F.3d at 1065. Here, Rossignol proceeded to manufacture, market and
 10 sell many products containing the accused binding during the period of Plaintiffs' silence and
 11 inaction, and to incur costs associated with such activities. To now permit Plaintiffs to maintain
 12 this action for damages and an injunction based upon the very activities in which Plaintiffs
 13 acquiesced by their silence and inaction would result in unfair and material prejudice to Rossignol.
 14 (Ex. 3, Marmonier Decl., ¶¶ 7 and 8).

15 In these circumstances, as in *Scholle*, summary judgment should be entered in favor of
 16 Rossignol declaring Plaintiffs' patents to be unenforceable against Rossignol, and Plaintiffs' action
 17 against Rossignol to be barred, based on equitable estoppel.

18 **C. Even If Enforceable, Plaintiffs' Asserted Patent Claims Are Not**
 19 **Infringed By Rossignol's Accused Binding, As Admitted By Plaintiffs**

20 There are many reasons why Rossignol's accused binding does not infringe Plaintiffs'
 21 asserted patent claims and, if necessary, Rossignol will present all of such reasons if this case
 22 proceeds. However, based on admissions in Plaintiffs' Infringement Contentions, it is clear now
 23 that Rossignol's accused binding does not infringe at least for the reasons discussed below.
 24 Moreover, such reasons are more than sufficient for purposes of this motion, given that the
 25 absence of even a single claim limitation from an accused product requires a determination of
 26 noninfringement. *Southwall*, 54 F.3d at 1575.

1 **1. Law Relating To Noninfringement**

2 Claims typically must be construed before determining whether or not they are infringed or
3 invalid, and must be construed the same way for both purposes. *Amazon.com, Inc. v.*
4 *Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001); *Markman v. Westview*
5 *Instruments, Inc.*, 52 F.3d 967, 976, 996 n. 7 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370
6 (1996). However, this does not preclude early summary judgment of noninfringement in a case
7 where, as here, it is evident from the patentee's infringement analysis that one or more claim
8 limitations are missing from the accused product. *See, e.g., Faroudja Labs., Inc. v. Dwin Elecs.,*
9 *Inc.*, 1999 WL 111788, *3-4 (N.D. Cal. 1999) (Ex. 16) (summary judgment of noninfringement of
10 596 patent without a *Markman* hearing due to absence of claimed film-to-television feature in
11 accused device and process); *Globetrotter Software, Inc. v. Elan Computer Group, Inc.*, 1999 WL
12 33490210, *2 and *6-7 (N.D. Cal. 1999), *aff'd*, 236 F.3d 1363 (Fed. Cir. 2001) (Ex. 17) (summary
13 judgment of noninfringement of claim 55, granted simultaneously with claim construction order,
14 due to absence of claimed prevention function in accused device). Moreover, any necessary claim
15 construction can be just as well conducted in the context of a summary judgment motion as in a
16 separate *Markman* hearing, *Markman*, 52 F.3d at 981 (claim construction may be conducted "in
17 the context of dispositive motions"), particularly given that "only those terms need to be construed
18 that are in controversy, and only to the extent necessary to resolve the controversy." *Vivid Techs.,*
19 *Inc. v. American Science & Eng'r., Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). This is especially so
20 in relatively simple cases where the claims use ordinary words whose meanings can be readily
21 understood. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*); *see also*
22 *Rogers v. Desa Int'l, Inc.*, 166 F.Supp.2d 1202, 1204-05 (E.D. Mich. 2001) (no need for *Markman*
23 hearing before granting summary judgment where there is "lack of technical and linguistic
24 complexity and lack of conflicting factual evidence" and "the papers filed are sufficient to construe
25 the claims").

26 To determine infringement or noninfringement, a claim is compared to an accused product
27 to determine whether such product infringes the claim. *Markman*, 52 F.3d at 976. To establish
28

1 infringement, every claim limitation must be found in an accused product. *Warner-Jenkinson Co.*
 2 *v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29, 40 (1997). The patentee must prove infringement
 3 by a preponderance of the evidence. *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241,
 4 1247 (Fed. Cir. 2000).

5 If a claim "reads on" an accused product, i.e., the accused product embodies each limitation
 6 set forth in the claim exactly, the accused product is said to literally infringe the claim. *Cole v.*
 7 *Kimberly-Clark Corp.*, 102 F.3d 524, 532 (Fed. Cir. 1996). In the absence of literal infringement,
 8 infringement may sometimes be found under the doctrine of equivalents if the accused product
 9 contains features that are identical or equivalent to each claimed element. *Warner-Jenkinson*, 520
 10 U.S. at 21 and 40. However, Plaintiffs have waived infringement by equivalency in this case by
 11 failing to rely upon equivalency in their Infringement Contentions as required by Patent L.R. 3-
 12 1(d). In any event, infringement could not be found in this case literally or under the doctrine of
 13 equivalents because, as admitted by Plaintiffs and demonstrated below, Rossignol's accused
 14 binding is missing entire limitations of Plaintiffs' asserted claims. *See, e.g., Freedman Seating Co.*
 15 *v. American Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005) (no infringement literally or under
 16 the doctrine of equivalents where an entire claim limitation is missing from an accused product).

17 **2. Plaintiffs Have Admitted That Rossignol's Accused**
 18 **Binding Is Missing The "Rotation Of The Upper**
 19 **Attachment Relative To The Lower Attachment" Element**
Of The Asserted Claims, And Therefore Does Not Infringe

20 As noted above, claim 1 of the 530 Patent requires "rotation of the upper attachment
 21 relative to the lower attachment." In other words, as is clear from the 530 Patent specification, the
 22 entire upper attachment rotates relative to the entire lower attachment. (Ex. 1, 530 Patent, C4/L66-
 23 C5/L8, C7/L52-C8/L14 and Figs. 1 and 5). *See also, e.g., Zodiac Pool Care Inc. v. Hoffinger*
 24 *Indus. Inc.*, 206 F.3d 1408, 1414 (Fed. Cir. 2000) (noninfringement ruling, noting "[T]he
 25 limitation recites a relationship between the edge and the stop, not a relationship between the edge
 26 and a portion of the stop."). As admitted by Plaintiffs, Rossignol's accused binding does not meet
 27 this claim limitation.

1 In their Infringement Contentions, Plaintiffs contend that the upper attachment in
 2 Rossignol's accused binding is the plate 3 that is fixed to the boot, and that the lower attachment in
 3 Rossignol's accused binding includes rotatable base 4, hold-down disc 5B (that is fixed to the
 4 snowboard), and an unidentified component 17. (Ex. 4, Claim Chart, p. 1, and attached
 5 photographs; Plaintiffs' reference numbers used here). As is indisputable from both the
 6 photographs attached to Plaintiffs' Infringement Contentions (Ex. 4) and from Rossignol's product
 7 photographs submitted herewith (Ex. 2), alleged upper attachment plate 3 of Rossignol's accused
 8 binding rotates with base 4 of the alleged lower attachment, not relative to base 4. In other words,
 9 alleged upper attachment plate 3 does *not* rotate relative to the entire alleged lower attachment in
 10 Rossignol's accused binding. Thus, by Plaintiffs' own admission, Rossignol's accused binding is
 11 missing the "rotation of the upper attachment relative to the lower attachment" limitation, and
 12 therefore does not infringe asserted claim 1 of the 530 Patent or any of the asserted claims
 13 depending from claim 1.³

14 **3. Plaintiffs Have Admitted That Rossignol's Accused Binding**
 15 **Is Missing The "Automatically Engage With Each Other**
 16 **To Lock ... And To Permit Rotation" Element of the**
 17 **Asserted Claims, And Therefore Does Not Infringe**

18 Claim 1 of the 530 Patent also recites "the coupling mount and the coupler being
 19 configured *to automatically engage with each other to lock* the upper attachment to the lower
 20 attachment ... *and to permit rotation* of the upper attachment relative to the lower attachment"
 21 (Emphasis added). In other words, as is clear from the 530 Patent specification, the coupling
 22 mount and coupler are configured so that their automatic engagement with each other provides for
 23 both (1) locking of the upper attachment to the lower attachment and (2) rotation of the upper
 24 attachment relative to the lower attachment. (Ex. 1, 530 Patent, e.g., C5/L3-8, C5/L29-38,
 25 C6/L40-54, C7/L59-65, C8/L9-14 and Figs. 1, 2C, 3, 3A and 5). As conceded by Plaintiffs,

26 ³ Where a claim is not infringed because the accused device does not include one or more claim
 27 limitations, then the claims depending from the non-infringed claim cannot be infringed for the
 28 same reason. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 685-86
 (Fed. Cir. 1990).

Rossignol's accused binding does not meet this claim limitation, even aside from Plaintiffs' above-discussed admission that the alleged upper attachment in Rossignol's accused binding does not rotate relative to the alleged lower attachment.

In their Infringement Contentions, Plaintiffs contend that locking of alleged upper attachment 3 to alleged lower attachment 5B, 4, 17 in Rossignol's accused binding is achieved by engagement of alleged coupler (boot pins) 6A, 6B with components 7A, 7B and 8A, 8B of alleged coupling mount (jaws) 5A. (Ex. 4, Claim Chart, p. 1, and attached photographs). By contrast, Plaintiffs do *not* contend that rotation in Rossignol's accused binding is permitted by such engagement, but rather contend that rotation in Rossignol's accused binding is permitted only "by unlatching 10," i.e., by actuating the rotation release mechanism identified by numeral 10 in the photographs attached to Plaintiffs' Infringement Contentions, so as to release the rotatable base 4. (*Id.*). Plaintiffs were forced to formulate their contentions in this manner by the indisputable fact that, in Rossignol's accused binding, engagement of alleged coupler 6A, 6B and alleged coupling mount 5A does *not* provide for rotation of the boot relative to the board at all, much less rotation of upper attachment part 3 relative to lower attachment part 4. Thus, by Plaintiffs' own admission, Rossignol's accused binding is missing a coupling mount and coupler that are configured as required by the "automatically engage with each other to lock ... and to permit rotation" limitation, and therefore Rossignol's accused binding does not infringe asserted claim 1 of the 530 Patent or any of the asserted claims depending from claim 1.

4. Plaintiffs Have Admitted That Rossignol's Accused Binding Is Missing The "Without Release" Element Of The Asserted Claims, And Therefore Does Not Infringe

A further requirement of asserted independent claim 1 of the 530 Patent is that the coupler and coupling mount must be configured to automatically engage with each other "to permit rotation of the upper attachment relative to the lower attachment when the upper attachment is locked to the lower attachment *without release of said upper attachment from said lower attachment.*" (Emphasis added). In other words, as is clear from the 530 Patent specification, when the upper attachment is engaged with and locked to the lower attachment, before being

1 latched in a selected rotary position with the disclosed rotary position lock, the upper attachment is
 2 rotatable relative to the lower attachment without the need to first actuate a release mechanism to
 3 enable such relative rotation. (Ex. 1, 530 Patent, e.g., C5/L3-8, C6/L51-54, C9/L20-23, 45-50 and
 4 Figs. 1, 5 and 10). As conceded by Plaintiffs, Rossignol's accused binding does not meet this
 5 claim limitation, even aside from Plaintiffs' above-discussed admission that the alleged upper
 6 attachment in Rossignol's accused binding does not rotate relative to the alleged lower attachment.

7 As noted above, in their Infringement Contentions Plaintiffs contend only that rotation in
 8 Rossignol's accused binding is permitted by unlatching rotation release mechanism 10. (Ex. 4,
 9 Claim Chart, p. 1, and attached photographs). In other words, with the alleged upper attachment 3
 10 of Rossignol's accused binding locked to the alleged lower attachment 5B, 4, 17 (i.e., the boot
 11 locked to the snowboard), the alleged upper attachment does *not* rotate relative to the alleged
 12 lower attachment at all, much less "without release of said upper attachment from said lower
 13 attachment" as required by claim 1. Rather, a release mechanism must be actuated in Rossignol's
 14 accused binding to permit any rotation of the boot relative to the board (and even then alleged
 15 upper attachment part 3 *never* rotates relative to alleged lower attachment part 4). Thus, by
 16 Plaintiffs' own admission, Rossignol's accused binding is missing the "without release" limitation,
 17 and therefore does not infringe asserted claim 1 of the 530 Patent or any of the asserted claims
 18 depending from claim 1.

19 **5. Plaintiffs Have Admitted That Rossignol's Accused Binding**
 20 **Is Missing The "Coupling Mount Attached ..." Element Of**
 21 **The Asserted Claims, And Therefore Does Not Infringe**

22 Claim 1 of the 530 Patent also requires "a coupling mount *attached* to the other of said
 23 upper and lower attachments," by contrast to its further recitation of "a lower attachment
 24 *connectable* to a board." (Emphasis added). As conceded by Plaintiffs, Rossignol's accused
 25 binding does not meet the "coupling mount attached..." claim limitation.

26 The varying use of "connectable" versus "attached" in claim 1 is not coincidental. The 530
 27 Patent specification describes lower attachment plate 216 as being "connected" to a snowboard
 28 and, by contrast, describes coupling mount 222 as being "attached" to lower attachment plate 216.

(Ex. 1, 530 Patent, C5/L1-3). In this way, Plaintiffs differentiated between an attachment plate that may be directly or indirectly connected to the snowboard (e.g., 530 Patent Fig. 3A: mounting plate 304 of lower attachment plate 216 connected to the snowboard via alignment ring 302 and spacer 300) and the direct attaching of the coupling mount to the attachment plate (e.g., 530 Patent Fig. 3A: direct attaching of coupling mount 322 (sic, 222) to mounting plate 304). This use of the word "attached" to denote a direct fastening versus the word "connected" to denote a direct or indirect fastening is recognized in the prevailing case law. *See, e.g., Searfoss v. Pioneer Consolidated Corp.*, 374 F.3d 1142, 1149-50 (Fed. Cir. 2004) (recognizing the distinction between "connecting" that may denote direct or indirect fastening and "attaching" that denotes direct fastening). Through use of the word "connectable" (i.e., capable of being connected) in claim 1 rather than "connected," Plaintiffs even further differentiated the contrasting use of the word "attached."

In their Infringement Contentions, Plaintiffs admit that the alleged coupling mount in Rossignol's accused binding is not "attached" (i.e., directly fastened) to either of the alleged upper and lower attachments. Rather, Plaintiffs state that alleged coupling mount 5A is "attached to 5B via fork 17, 25." (Ex. 4, Claim Chart, p. 1, and attached photographs). Thus, by Plaintiffs' own admission, Rossignol's accused binding is missing the "coupling mount attached ..." limitation, and therefore does not infringe asserted claim 1 of the 530 Patent or any of the asserted claims depending from claim 1.

**D. The Asserted Claims Of The 530 Patent Are Invalid, Particularly
If Applied So As To Cover Rossignol's Accused Binding**

If necessary, Rossignol will demonstrate later in this case that Plaintiffs' asserted patent claims are invalid in view of the prior art and for additional reasons regardless of how the claims are construed, and that, if Plaintiffs' asserted claims are narrowly construed in an effort to preserve their validity, they are not infringed. However, it is evident at this early stage of the case that Plaintiffs' asserted claims are clearly invalid in view of the prior art if applied so as to cover Rossignol's accused binding as alleged in Plaintiffs' Infringement Contentions. This is because there is substantial prior art that, like Rossignol's accused binding, includes one mechanism for

1 locking a boot to a snowboard and a second mechanism for permitting rotation of the boot relative
 2 to the snowboard with the boot locked in the binding. We present below just a few examples,
 3 while reserving Rossignol's right to present others if this case goes forward.

4 **1. Law Relating to Invalidity**

5 A U.S. patent is presumed to be valid. 35 U.S.C. § 282. However, the presumption of
 6 validity can be overcome by clear and convincing evidence that the patent is invalid. *SIBIA*
 7 *Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000). The bases for
 8 holding a patent invalid include, among others, that the claims are anticipated by or would have
 9 been obvious in view of the prior art as discussed below. In the case of prior art-based invalidity,
 10 the clear and convincing burden of proof may be more easily met through reliance upon prior art
 11 that was not before the examiner during prosecution. *Id.* at 1355-56. However, patent claims
 12 nonetheless have been held invalid based upon prior art that was before the examiner. *See, e.g.*,
 13 *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1319, 1322 n.2, 1325 (Fed. Cir. 2004)
 14 (claims obvious in view of the same and cumulative prior art); *Brown v. 3M*, 265 F.3d 1349, 1351-
 15 54 (Fed. Cir. 2001) (claim anticipated by the same prior art); *Celeritas Techs. Ltd. v. Rockwell Int'l*
 16 *Corp.*, 150 F.3d 1354, 1360-61 (Fed. Cir. 1998) (claims anticipated by the same prior art).

17 Prior art may be in a number of forms. For example, the prior art may be (1) a patent or
 18 printed publication in the United States or a foreign country, or a public use or offer for sale in the
 19 United States, more than one year before the earliest effective U.S. filing date of the patent (35
 20 U.S.C. §102(b)); (2) knowledge or use by others in the United States, or a patent or printed
 21 publication in the United States or a foreign country, before the invention thereof by the patentee
 22 (35 U.S.C. §102(a)); or (3) a patent granted on, or a publication of, a patent application by another
 23 filed in the United States before the invention thereof by the patentee (35 U.S.C. §102(e)). Other
 24 examples are provided in 35 U.S.C. §102.

25 If all claimed elements/steps are disclosed, expressly or inherently, in a single prior art
 26 reference, that reference is said to "anticipate" the claimed invention, thereby invalidating the
 27
 28

1 claim(s) under 35 U.S.C. §102 for lack of novelty. *Transclean Corp. v. Bridgewood Servs., Inc.*,
2 290 F.3d 1364, 1370 (Fed. Cir. 2002). In the absence of an anticipatory prior art reference, the
3 issue becomes whether "the differences between the subject matter sought to be patented and the
4 prior art are such that the subject matter as a whole would have been obvious at the time the
5 invention was made to a person having ordinary skill in the art to which said subject matter
6 pertains." 35 U.S.C. §103(a). In determining obviousness, the following four factors must be
7 considered: (1) the scope and content of the prior art; (2) any differences between the prior art and
8 the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) any secondary
9 considerations evidencing nonobviousness, such as commercial success, copying, long felt but
10 unsolved needs, failures of others, unexpected results, etc. *Graham v. John Deere Co.*, 383 U.S. 1,
11 17-18 (1966).

12 Prior art references may be modified or combined to render obvious a subsequent invention
13 if there was some suggestion or motivation to do so derived from the prior art itself, the nature of
14 the problem to be solved, or the knowledge of one of ordinary skill in the art. *SIBIA*
15 *Neurosciences*, 225 F.3d at 1356; *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).
16 The suggestion or motivation need not be expressly stated, *Medical Instrumentation and*
17 *Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221 (Fed. Cir. 2003), and the prior art need not
18 be modified or combined for the same reasons contemplated by the inventor, *Pfaff v. Wells Elecs.*,
19 *Inc.*, 124 F.3d 1429, 1439 (Fed. Cir. 1997), *aff'd*, 525 U.S. 55 (1998).

20 The level of skill in the art is determined entirely with reference to a hypothetical person of
21 ordinary skill in the art presumed to be aware of all of the pertinent prior art. Relevant factors in
22 determining the level of skill include the educational level of active workers in the field, the type
23 of problems encountered in the art, prior art solutions to such problems, the rapidity of innovations
24 in the art, and the sophistication of the technology. *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed.
25 Cir. 1995).

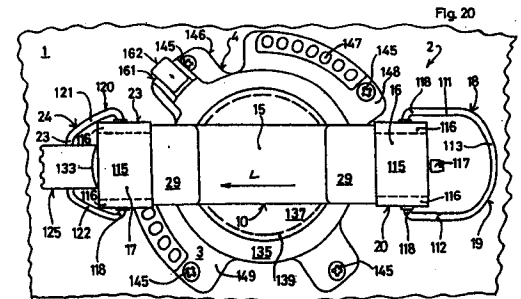
26 In order for secondary considerations evidence to be given substantial weight in an
27 obviousness analysis, the patentee must demonstrate that there is a nexus between such evidence
28

1 and the merits of the claimed invention. *Id.* at 1580. In other words, the secondary considerations
 2 evidence must arise from the patented invention as claimed, rather than from extrinsic influences
 3 such as a disclosed but unclaimed feature or a feature of the prior art. *Id.*

4 **2. Plaintiffs' Asserted Claims Are Invalid Under 35 U.S.C. §102(b)**
 5 **As Anticipated By PCT Publication WO 89/08480 (AITEC)**

6 International PCT Publication No. WO 89/08480 (Ex. 5 (with English translation),
 7 hereinafter "AITEC") was published on September 21, 1989, more than one year before the earliest
 8 possible U.S. filing date of the 530 Patent, and thus constitutes prior art to the 530 Patent under 35
 9 U.S.C. §102(b). AITEC was not cited during prosecution of the 530 Patent.

10 AITEC disclosed multiple embodiments of a rotatable, automatic engagement snowboard
 11 binding (Fig. 20 embodiment shown and described
 12 here). The AITEC binding included a plate 3 fixed to
 13 a snowboard 1, and a boot restraining mechanism 10,
 14 18, 24 (for automatic locking of a snowboarder's boot
 15 to the snowboard when the snowboarder steps onto
 16 the snowboard) mounted on a rotor 135 that was
 17 rotatable with respect to plate 3 and the snowboard.



18 A quick release locking mechanism 162 on rotor 135 could be released and then relatched in any
 19 of a number of catch openings 147 to permit the boot restraining mechanism to be rotated, with the
 20 boot locked in the binding, so as to adjust the rotary position of the boot with respect to the
 21 snowboard.

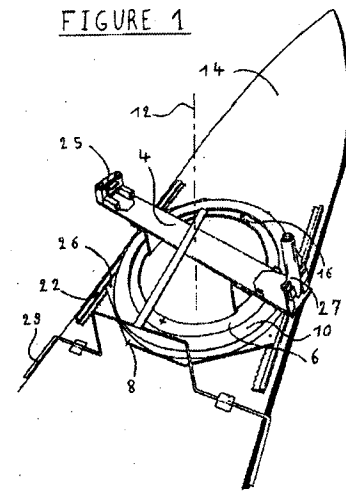
22 As more clearly shown in the Ex. 10 chart, AITEC disclosed, expressly or inherently, every
 23 element of every one of Plaintiffs' asserted claims, and therefore anticipates those claims. Thus,
 24 Plaintiffs' asserted claims are invalid for anticipation by AITEC.

25 **3. Plaintiffs' Asserted Claims Are Invalid Under 35 U.S.C. §102(b)**
 26 **As Anticipated By French Patent Publication 2,618,688 (Scott)**

27 French Patent Publication No. 2,618,688 to Scott de Martinville (Ex. 6 (with English
 28 translation), hereinafter "Scott") was published on February 3, 1989, more than one year before the

1 earliest possible U.S. filing date of the 530 Patent, and thus constitutes prior art to the 530 Patent
 2 under 35 U.S.C. §102(b). Scott was not cited during prosecution of the 530 Patent.

3 Scott disclosed a rotatable, automatic engagement snowboard binding (Fig. 1 of Scott
 4 shown and described here). The Scott binding included a
 5 plate 8 and a ring 10 fixed (in slides 22) to a snowboard 14,
 6 and a boot restraining mechanism 4, 25, 27 (for automatic
 7 locking of a snowboarder's boot to the snowboard when the
 8 snowboarder steps onto the snowboard) mounted on a ring 6
 9 that was rotatable with respect to plate 8, ring 10 and the
 10 snowboard. The rotatable boot restraining mechanism could
 11 be locked or released with fasteners 16, accessible with the
 12 boot locked in the binding, to permit the boot to freely rotate relative to the snowboard or to permit
 13 adjustment of the rotary position of the boot with respect to the snowboard.



14 As more clearly illustrated in the Ex. 11 chart, Scott disclosed, expressly or inherently,
 15 every element of every one of Plaintiffs' asserted claims, and therefore anticipates those claims.
 16 Thus, Plaintiffs' asserted claims are invalid for anticipation by Scott.

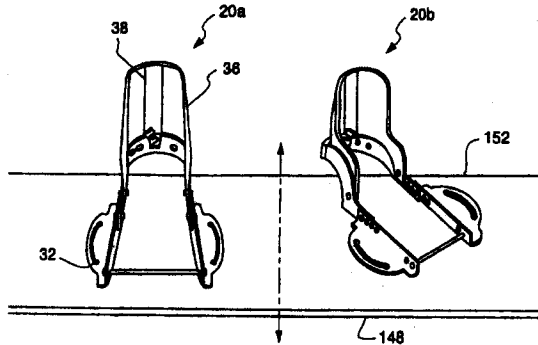
17 **4. Plaintiffs' Asserted Claims Are Alternatively Invalid Under**
 18 **35 U.S.C. §103(a) For Obviousness From AITEC Or Scott**
 19 **In View Of One Another And/Or Additional Prior Art**

20 If AITEC or Scott is determined to be missing any element of any of Plaintiffs' asserted
 21 claims, such claims nonetheless would have been obvious from AITEC or Scott in view of one
 22 another, U.S. Patent No. 5,660,410 ("Alden"), U.S. Patent No. 5,520,406 ("Anderson") and/or U.S.
 23 Patent No. 5,577,755 ("Metzger") (Exs. 7, 8 and 9). Alden, Anderson and Metzger respectively
 24 issued from patent applications filed on March 2, 1995 (based on a continuation-in-part
 25 application filed on December 9, 1994), August 18, 1994, and July 11, 1994, and thus constitute
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 27
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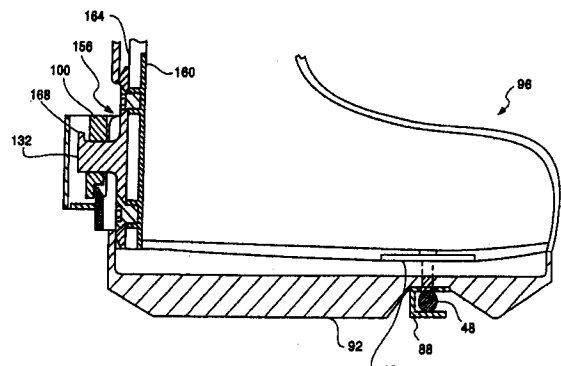
1 prior art to the 530 Patent under 35 U.S.C. §102(e).⁴ Alden was not cited during prosecution of
 2 the 530 Patent.

3 Pertinent features of Alden, Anderson and Metzger are illustrated in the chart Exs. 12, 13
 4 and 14. While Rossignol believes, as shown in Exs. 12 and 13, that each of Alden and Anderson
 5 also anticipates all of the asserted claims of the 530 Patent if such claims are applied so as to cover
 6 Rossignol's accused binding, for simplicity such references are relied upon in this motion only in
 7 combination with AITEC and/or Scott.

8 As seen in Exs. 7, 8, 12 and 13 (and the Figures from the references set forth here), Alden
 9 and Anderson each disclosed a rotatable, automatic engagement snowboard binding. Each

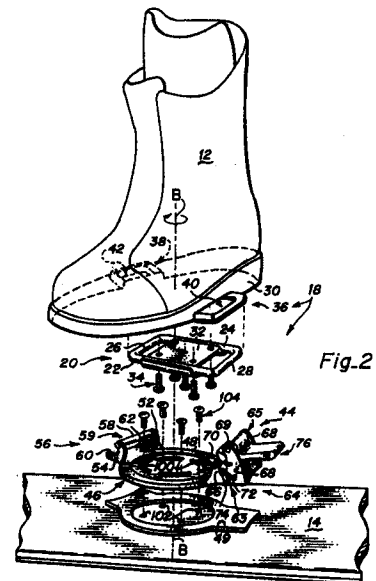


Alden Fig. 1



Alden Fig. 3

16 binding included a first, rotatable portion (Alden: 20a, 20b;
 17 Anderson: 48) fastened to a snowboard, and a second portion
 18 (Alden: 88, 132; Anderson: 22, 24, 26, 28, 32) fastened to a
 19 snowboarder's boot for coupling with the first portion (for
 20 automatic locking of a snowboarder's boot to the snowboard
 21 when the snowboarder steps onto the snowboard). Each
 22 binding included distinct upper and lower attachment and
 23 coupling hardware (as shown). The Anderson binding, like
 24 Rossignol's accused binding, included pins 22, 24, 26, 28
 25

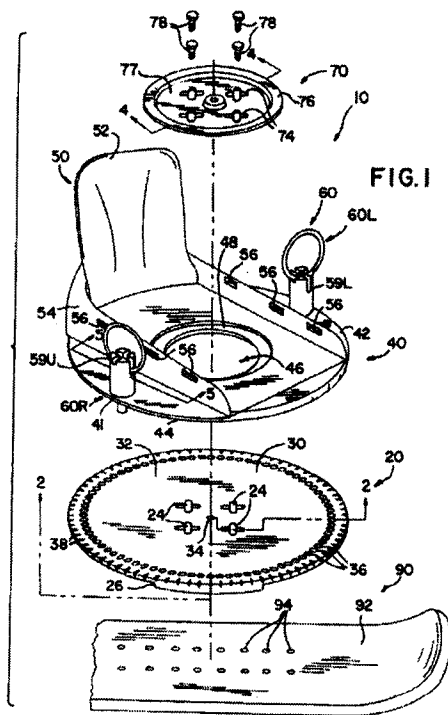


Anderson

26 ⁴ Anderson may constitute prior art under §102(b) if the 530 Patent is determined not to be entitled
 27 to the benefit of its June 25, 1996 provisional application filing date. However, for purposes of
 28 this motion, Anderson is treated as prior art under §102(e).

1 fastened to a boot with a plate 32 and laterally extending from the bottom of the boot to engage
 2 with lateral jaws (shown generally at arrows 56 and 44) on the rotatable binding portion 48
 3 fastened to the snowboard. Each of Alden and Anderson further disclosed that the rotatable
 4 portion of the binding could be locked or released with fasteners (Alden: 32; Anderson: 104), to
 5 permit the boot to rotate with respect to the snowboard or to permit adjustment of the rotary
 6 position of the boot with respect to the snowboard. Alden's fasteners were accessible with the
 7 boots locked in the bindings.

8 As seen in Exs. 9 and 14 (and Fig. 1 of Metzger set forth here), Metzger disclosed a



9 rotatable strap-type snowboard binding. Like Rossignol's
 10 accused binding, Metzger's binding included a base plate
 11 20 fixed to a snowboard 90, with a boot restraining
 12 member 40 rotatably mounted to the base plate. The boot
 13 restraining member had left and right locking assemblies
 14 60R, 60L, each of which included a retractable pin that
 15 could be engaged with any of a number of holes 36
 16 through the periphery of the base plate to lock the boot
 17 restraining member in a desired rotary position, or to
 18 change the rotary position of the boot restraining
 19 member, with the boot locked in the binding.⁵ The
 20 locking assembly pins could also be retracted to permit

21 the boot restraining member to freely rotate relative to the base plate and hence the snowboard.

22 It would have been obvious to modify AITEC or Scott, in view of the clear teachings of
 23 one another and the other references discussed above, to employ different coupling and/or rotation

24
 25 ⁵ Such a rotation mechanism (with a quick-release rotary position lock), operable with the boots
 26 locked in the bindings, was likewise included in snowboard bindings sold by Look Snowboards, a
 27 Rossignol subsidiary, as long ago as the 1990/1991 season. (See Ex. 15, 1990/1991 Look
 28 Snowboards brochure (and English translation), which is printed publication prior art to the 530
 Patent under 35 U.S.C. §102(b)).

1 mechanisms, such as those used in Rossignol's accused binding. For example, one of ordinary
2 skill in the art would have been motivated, by the clear teachings of Alden and/or Anderson, to
3 substitute the automatic boot restraining/locking mechanism taught by Alden or Anderson, with its
4 particular, distinct upper and lower attachments, coupler and coupling mount, for the automatic
5 boot restraining/locking mechanism of AITEC or Scott, so as, e.g., to ensure positive locking and
6 easy release of the boot to and from the board. This is especially so given that the Alden and
7 Anderson bindings, like those of AITEC and Scott, are rotatable, automatic engagement bindings.
8 By way of an additional example, one of ordinary skill in the art would have been motivated to
9 substitute Metzger's particular rotation mechanism (with its quick-release rotary position locks) for
10 AITEC's or Scott's rotation mechanism, or to substitute Metzger's or AITEC's quick-release rotary
11 position locks for Scott's fasteners 16, so as, e.g., to achieve a simple, dependable rotary position
12 locking mechanism capable of 360° free rotation or rotary position adjustment.⁶ In addition to
13 motivations provided by the nature of the problem to be solved and the knowledge of the
14 ordinarily skilled artisan, one of ordinary skill in the art would have been motivated to so combine
15 the various features of the references because the references clearly teach the benefits to be
16 achieved by combining automatic engagement, locking and rotation features, and because the
17 elements of the asserted 530 Patent claims appear in the prior art in the same configurations, being
18 used in the same way, and serving the same functions/purposes as claimed in the 530 Patent. *See,*
19 *e.g., In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991).⁷ Moreover, where, as here, the teachings
20 relied upon to show obviousness are repeated in a number of references, the conclusion of
21 obviousness is strengthened. *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1149 (Fed. Cir. 1983)
22 (cited in *Gorman*).

23
24 ⁶ One of ordinary skill in the art also would have been motivated to employ Metzger's rotation
25 mechanism in Alden or Anderson, e.g., so as to provide quick release rotary position locks to the
26 left and right of the boot in lieu of Alden's fasteners 32 and Anderson's fasteners 104.

27 ⁷ The level of skill in the art is relatively high, as reflected, e.g., by the problems encountered and
28 solutions provided in the prior art. Rossignol is aware of no secondary considerations evidence
that would suggest the nonobviousness of Plaintiffs' asserted claims. Indeed, any alleged
secondary considerations evidence (e.g., commercial success, etc.) was clearly due to unclaimed or
prior art features and not to any alleged invention.

Thus, if any of Plaintiffs' asserted claims are determined not to be anticipated by AITEC or Scott, such claims certainly would be invalid as a matter of law for having been obvious from AITEC or Scott in view of one another, Alden, Anderson and/or Metzger.

IV. CONCLUSION

In view of the above, Plaintiffs are equitably estopped from proceeding with this case against Rossignol and, in any event, Plaintiffs' asserted patent claims are not infringed and are invalid. Accordingly, Rossignol's motion for summary judgment should be granted, and this case should be dismissed with prejudice.

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Respectfully submitted,

ROSSIGNOL SKI COMPANY, INC.

By: s/Edward P. Walker

EDWARD P. WALKER (*Pro Hac Vice*)

JOHN W. O'MEARA (*Pro Hac Vice*)

VU Q. BUI (*Pro Hac Vice*)

OLIFF & BERRIDGE, PLC

277 South Washington Street, Suite 500

Alexandria, VA 22314

Telephone: (703) 836-6400

Facsimile: (703) 836-2787

Email: ewalker@oliff.com;

jomeara@oliff.com;

vbui@oliff.com

KENNETH L. NISSLY (CA Bar No. 77589)

SUSAN van KEULEN (CA Bar No. 136060)

THELEN REID & PRIEST LLP

225 West Santa Clara Street, Suite 1200

San Jose, CA 95113-1723

Telephone: (408) 292-5800

Facsimile: (408) 287-8040

Email: kennissly@thelenreid.com;

svankeulen@thelenreid.com

Attorneys for Defendant/Counterclaim Plaintiff
Rossignol Ski Company, Inc.